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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,626	05/31/2001	Keiichi Maeda	SON-1539/CON	7772

7590

05/13/2003

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EXAMINER

MAYEKAR, KISHOR

ART UNIT

PAPER NUMBER

1753

DATE MAILED: 05/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,626

Applicant(s)

K. MARDA

Examiner

K. MAYRKAH

Group Art Unit

1753

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period of Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 2/26/03

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 2, 4, 8, 9 and 11 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2, 4, 8, 9 and 11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 9 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is indefinite for the reciting of the phrase "whereby" for reasons as of record.

Claim Rejections - 35 USC § 102 and § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 2, 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over DOTZER et al. (4,053,383), a reference cited in the last Office action. DOTZER's invention is directed to an apparatus for electrodepositing aluminum. DOTZER discloses in Figures 1 and 2 that the apparatus comprises all the structure elements as claimed. The difference between DOTZER and the above claims is the manner of operating the apparatus. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified DOTZER's teachings because it has been held that the manner in which the an apparatus operates is not germane to the issue of patentability of the apparatus itself, *Ex parte Wikdahl* 10 USPQ 2d 1546, *Ex parte McCullough* 7 USPQ 2d 1889, *In re Finsterwalder* 168 USPQ 530, *In re Casey* 152 USPQ 235.

As to the subject matter of claim 9, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified DOTZER's teachings because it has been held on the intended use of apparatus that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. V. Bausch & Lomb Inc.*, 15 USPQ 2d 1525.

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4. Claims 2, 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over BIRKLE et al. (4,759,831), a reference cited in the last Office action. BIRKLE's invention is directed to an apparatus for electrodepositing aluminum. BIRKLE discloses in Figure 1 and col. 5, lines 59-64 that the apparatus comprises all the structure elements as claimed. The difference between BIRKLE and the above claims is the manner of operating the apparatus. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified BIRKLE's teachings because it has been held that the manner in which the an apparatus operates is not germane to the issue of patentability of the apparatus itself, *Ex parte Wikdahl* 10 USPQ 2d 1546, *Ex parte McCullough* 7 USPQ 2d 1889, *In re Finsterwalder* 168 USPQ 530, *In re Casey* 152 USPQ 235.

As to the subject matter of claim 9, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified BIRKLE's teachings because it has been held on the intended use of apparatus that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. V. Bausch & Lomb Inc.*, 15 USPQ 2d 1525.

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5. Claims 2, 4, 8 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by STOGER et al. (4,176,034). See Figures 1 and 2; abstract; col. 5, lines 14-19 and lines 35-39, col. 7, lines 51-68, and col. 2, lines 22-31.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over STOGER '034. The difference between STOGER and the instant claim is the intended use of the plating chamber. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified STOGER's teachings because it has been held on the intended use of apparatus that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. V. Bausch & Lomb Inc.*, 15 USPQ 2d 1525.

Response to Arguments

7. Applicant's arguments filed February 26, 2003 have been fully considered but they are not persuasive.

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In response to Applicant's arguments that "none of the cited prior art references teaches or suggests an apparatus where a pre-treating chamber, a transportation chamber, and an electroplating chamber are combined to be maintained together in a non-oxidative atmosphere", since the maintaining of these chambers are process operations, the manner of operating the apparatus cannot be given any patentable weight as set forth above. However this is not applied to the rejection of claims as being anticipated by STOGER et al.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

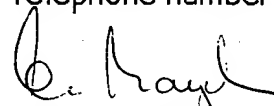
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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (703) 308-3322. The fax phone number for this Group is (703) 872-9310 (non-after finals) or 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Kishor Mayekar
Primary Examiner
Group 1700

KM
May 12, 2003